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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/469,644	12/22/1999	ALLAN R. GRIEBENOW	065446.0128	5227

5073 7590 09/19/2005

BAKER BOTTS L.L.P.  
2001 ROSS AVENUE  
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DALLAS, TX 75201-2980

EXAMINER
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PHILIPPE, GIMS S

ART UNIT	PAPER NUMBER
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2613

DATE MAILED: 09/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/469,644

Applicant(s)

GRIEBENOW, ALLAN R.

Examiner

Gims S. Philippe

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11, 13-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Response to Amendment***

1. Applicant's response received on June 21<sup>st</sup> 2005 has been fully considered and entered, but the arguments are not deemed to be persuasive.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-11, and 13-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vaio (US Patent no. 6,271,752) in view of Aviv (US Patent no. 6,028,626), and further in view of Nerlikar (US Patent no. 5,629,981) for the same reasons as previously set forth in the last office action mailed on March 23, 2005.

Regarding the above claims, the applicant argues that "the fact that the reference can be combined or modified does not render the resultant combination [or modification] obvious unless the prior art suggest the desirability of the combination". The examiner respectfully disagrees because not every prior art/reference will give a detailed explanation of the various way such prior art can and will be used. In fact, Nerlikar in col. 19, lines 10-47 clearly acknowledges many of the various possibilities that such

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prior art can be used. In addition, Vaios in col. 9, lines 49-67 and col. 10, lines 1-7 does not ignore the possibility of other modifications. What must be acknowledged is the fact that one prior art can be, and will be, used to show various obvious modifications. Once that one skilled in the art at the time of the invention can recognize the advantage of performing any modification over a particular prior art, what one would claimed as "patentable" is not.

The applicant further argues that the examiner is improperly using the applicant's disclosure as a blueprint for piecing together elements of Nerlikar with those of Vaios. And the fact that both system use RFID tags does not alone provide a suggestion to combine any aspects of the two systems, and that the examiner states, using the benefits of hindsight. The examiner respectfully disagrees. It is true that the examiner went over the applicant Specification to understand the invention, however, the hindsight argument is not really applicable. In fact, in examining one must at least combine prior art in the same field of endeavor. The applicant cannot deny that both Vaios and Nerlikar pertain to the same field of endeavor. Do both perform the same task? no, their invention would not be a valid. However, one skilled in the art must recognize when two-piece of prior art can complement each other. In the present case, the examiner did not act in hindsight nor used the applicant' specification as a blueprint. The suggestion is present in the prior art and one skilled in the art at the time of the invention would recognize the advantage of combining the teachings of Nerlikar with the

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combination of Vaios and Aviv to show that the claimed limitation is obvious as a commonly used in audit -trial feature (See Nerlikar col. 8, lines 5-14).

The applicant further argues that in addition to claim 1 that he/she believes allowable, claim 8 recites "initiating a polling event in response to a specified event, ..., to use the RFID system to poll an area of the facility to determine an inventory of tagged items within the area". The examiner understand the applicant's argument, however, is the claim suggest using RFID in polling? If yes, then Aviv clearly shows that such practice is well known in the art of RFID technology (See Aviv col. 9, lines 25-37, lines 60-64, and col. 8, lines 45-51).

The applicant argues of the predefined alert condition that the RFID action corresponds to. The examiner remind the applicant that a monitoring service providing access to a subscriber must provide some predefined conditions that the subscriber must fulfill in order to be granted access. In other words, claim 20 does not recite any limitation that is considered not inherent or non-obvious to one skilled in the art. In fact, the combination of Vaios along with Aviv suggest granting access in Aviv col. 9, lines 60-67, col. 10, lines 1-10, and col. 13, lines 44-51.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gims S. Philippe whose telephone number is (571) 272-7336. The examiner can normally be reached on M-F (9:30-7:00) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dastouri S. Mehrdad can be reached on (571) 272-7418. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gims S Philippe  
Primary Examiner  
Art Unit 2613

GSP

September 14, 2005